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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,694	01/14/2002	Masashi Nakatsuka	Q67547	8610
23373	7590	12/17/2003	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037			FORD, JOHN M	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030691

Applicant(s)

Nakamura et al

Examiner

J.M. Ford

Group Art Unit

1024

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-6, 12, 15 and 16 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-6, 12, 15 and 16 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1624

What claims are in the application? See new Rule 121. The preliminary amendment begins with claim 3.

At this point, claim 1 cannot be understood, it is too long and has too many instances of substituted, without saying what the substituents are.

~~It~~ (claim 1) is *really* just too much to deal with. Does some method (means) of restriction appear to applicant? I am going to have to ask for an election ^{of} species. I cannot find a way to get around this claim; ~~some~~ way to identify a fixed heterocyclic ring, in the manner of *In re Harnish*, 226 USPQ 353.

In *Harnish*, coumarin was *fixed*. A single heterocyclic ring. Here, no heterocyclic ring is fixed. Classification is impossible.

This application contains claims directed to patentably distinct species.


Applicant is required, under 35 U.S.C. 121, to elect a single disclosed species for prosecution on the merits.

Applicant is advised that a response to this requirement must include an identification of the species that is elected, consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Claim 1 is generic to a plurality of patentably distinct species. Applicant is required, under 35 U.S.C. 121, to elect a single disclosed species, even if this requirement is traversed. See 37 CFR 1.143.

J. M. Ford: tg

December 15, 2003


JOHN M. FORD
PRIMARY EXAMINER
Group Art Unit 1624